

Application No. 10/756,195
Reply to Office Action dated May 17, 2005

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figures 4. This sheet, which includes Figs. 4-5, replaces the original sheet including Figs. 4-5.

Attachment: Replacement Sheet

REMARKS

Claims 1-30 will be pending upon entry of the present amendment. Claim 1 is being amended. Claims 9-15 have been withdrawn by the Examiner. Claims 23-30 are new. No new matter is being entered.

Drawings – Figure 4 has been amended to remove stray ink marks on the bottom surface of element 100 and 1 sheet of drawings is presented herewith for approval.

Claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner objected to “a strip-like shape” in lines 8-10 of claim 1. Claim 1 is being amended to remove that language. Accordingly, amended claim 1 and dependent claims 2-8 particularly point out and distinctly claim the invention.

Claims 1-3, 6, and 16-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wicker [US 2004/0113181].

Wicker does not anticipate claims 1-3, 6, and 16-18 because Wicker is not prior art. Wicker was filed on December 13, 2002. The present application claims priority from European Application No. 03425016.7, filed on January 15, 2003 (“the EP priority application”). Enclosed is a certified copy of the EP priority application together with an accurate English translation and a statement from Elena Cerbaro certifying the accuracy of the English translation. Accordingly, the applicants have perfected the priority claim back to January 15, 2003.

Also enclosed is a Rule 131 Declaration signed by one of the inventors, Fabio Pellizzer, stating that the claimed invention was conceived prior to December 13, 2002 and diligent steps were taken to reduce the invention to practice with the filing of the EP priority application on January 15, 2003. Accompanying the Pellizzer declaration are Appendixes A-C supporting the statements made in the declaration. In particular, Appendix A includes a draft patent application, prepared prior to December 13, 2002, that fully supports all of the pending claims of the present application. For example, claims 1-15 of the draft application are substantially the same as pending claims 1-15. In addition, the drawings and description of the invention included in the draft application are substantially the same as the present application.¹

¹ Although the draft patent application was almost entirely in English pages 9 and 13 include short notes in Italian. On page 9, lines 16 and 20, the term “confermare” means “confirm.” On page 13, lines 7-8, the sentence in Italian means “What delimits the length L1 at the other longitudinal extremity, not shown in the drawings???”.

Also enclosed is a Declaration of Elena Cerbaro, who is the European Patent Attorney who prepared the patent application that was filed as the EP priority application. The Cerbaro Declaration supports the statements in the Pellizzer Declaration that diligent steps were taken to reduce the invention to practice with the filing of the EP priority application. The Cerbaro Declaration includes Appendixes 1 and 2 in support of the statements made in the declaration.

The enclosed Pellizzer and Cerbaro declarations establish that the present invention was made prior to the December 13, 2002 filing date of Wicker. Accordingly, Wicker was not filed before the present invention was made, and thus, does not qualify as prior art under 35 U.S.C. § 102(e).

Claims 1-3, 6-8, 16-18, and 21-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ha [2004/0166604]. Claims 5 and 20 were rejected under 35 U.S.C. § 103 as being unpatentable over Ha.

Ha does not anticipate or render obvious claims 1-3, 5-8, 16-18, and 20-22 because Ha is not prior art. Ha was filed on February 25, 2003, which is after the priority date of the present application. In particular, as discussed above, the applicants have perfected the priority claim to the January 15, 2003 filing date of the EP priority application. Accordingly, Ha is not prior art under 35 U.S.C. § 102(e).

Claims 4-5 and 19-20 were rejected under 35 U.S.C. § 103 as being unpatentable over Ha in view of Lowery [WO 0209206]. Ha and Lowery do not render obvious claims 4-5 and 19-20 because Ha is not prior art for the reasons expressed above.

Claims 7-8 and 21-22 were rejected under 35 U.S.C. § 103 as being unpatentable over Ha in view of Bez [2003/0219924].

Ha and Bez do not render obvious claims 7-8 and 21-22 for at least two reasons. First, as discussed above, Ha is not prior art. Second, Bez cannot be used for a Section 103 rejection because Bez is assigned to the same assignees as the present application and does not qualify as prior art under any subsection of Section 102 with the possible exception of Section 102(e). Under Section 103(c), such a reference cannot be used to support an obviousness rejection. Accordingly, claims 7-8 and 21-22 are not unpatentable over Ha and Bez.

New claims 23-24 depend on claims 16 and 1, respectively, and thus, are in condition for allowance for the reasons specified above.

New claims 25-29 are directed to an electronic semiconductor device that includes a “contact structure positioned at least partially in a dielectric layer and including a first conducting region and a second conducting region, the second conducting region being of chalcogenic material, the first conducting region having a contact surface that contacts the second conducting region and extends transversely to the upper surface.” None of the cited prior art shows such a contact structure with a first conducting region having a contact surface that contacts a chalcogenic second conducting region and extends transversely to an upper surface of a semiconductor body. As discussed above, the only references cited by the Examiner as showing such a contact structure, Wicker and Ha, are not prior art.

The Examiner withdrew claims 9-15 from consideration and made final the restriction requirement.

The applicants respectfully request reconsideration of the restriction requirement. In the response to restriction requirement, the applicants pointed out that the Examiner had not and could not show that the product of claim 1 could be made by a process that is materially different from the process of claim 9. That is because claim 9 is substantially identical to claim 1 except that the word “forming” is placed before each of the structures of the device recited in claim 1. The Examiner’s response does not dispute that argument or attempt to point to any product of claim 1 could be made by a process that is materially different from the process of claim 9.

The Examiner incorrectly asserted that it was proper to compare the product of claim 1 with the process steps of dependent claim 11 to support the restriction requirement. The Examiner has asserted that the invention of claim 9 is independent and distinct from the invention of claim 1. In order to support that assertion, the Examiner must provide reasons why he believes that claims 1 and 9 are independent and distinct (See MPEP 816). Even if claim 11 were independent and distinct from claim 1, nothing logically or legally makes claim 9 independent and distinct from claim 1.

Because claim 9 is not independent and distinct from claim 1, it is a linking claim and should be examined with claim 1. As recited in MPEP 809.03, one example of a linking claim is “(B) a claim to the necessary process of making a product linking proper process and product claims.” As discussed above, claim 9 is directed to a necessary process of making the product of claim 1 because claim 9 is substantially identical to claim 1 except that the word “forming” is placed before each of the structures of the device recited in claim 1.

Given that claim 9 is substantially identical to claim 1 except for the addition of “forming,” claim 9 is allowable over the cited references for the reasons expressed above. Claims 10-15 are allowable given their dependence on claim 9. Accordingly, the applicants request allowance of claim 9 and rejoinder and allowance of claims 10-15.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



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Enclosures:

- Postcard
- Check
- 1 Sheet of Replacement Drawings (Figures. 4-5)
- Declaration of Elena Cerbaro
- Rule 131 Declaration of Fabio Pellizzer
- Certified Copy of European Application No. 03425016.7 w/
Translation and Declaration of Translation

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